

REMARKS

Currently claims 1-23 are present in the present application. The Examiner, in paragraph 3 of the Official Action, has maintained the rejection of claims 1-7 under 35 USC § 103(a) as being unpatentable over Nelson et al. (3,895,220) and has also maintained the rejection of claims 1-14, 16 and 21-23 under 35 USC § 103(a) as being unpatentable over Wentworth (5,547,226) in view of Hicks (5,359,387) and further in view of Johnson et al. (5,060,980).

The Examiner has also maintained the rejection of claims 17-20 under 35 USC § 103(a) as being unpatentable over Wentworth in view of Hicks and Johnson et al. and further in view of Kawai et al. (6,043,866) for the reasons set forth in paragraph 5.

In response to Applicant's previous arguments, the Examiner has stated of Nelson of providing a code. The Examiner argues that if the prior art structure is capable of performing the intended use, then it meets the claim. In this regard, the Nelson reference teaches a plurality of bars 18 of magnetizable ink (see column 3, line 11). These inks are used for ordering a particular quantity of items (see column 2, line 55 and column 3, lines 16-17). Since these parallel bars 18 are simply bars of magnetic ink, Applicants respectfully submit they are not capable of providing the intended use as taught and claimed by Applicant. In particular, the code of the present invention is used for "organizing" digital images that have been obtained by scanning. The only function in which the bars are used in Nelson and are capable of providing, is identifying the number of items to be provided. There is no teaching or suggestion that these bars can provide any type of instructions for organizing digital images obtained by scanning as taught and claimed by Applicant. Applicant respectfully submits that the structure taught by Nelson does not teach or suggest the function as taught and claimed by Applicant nor is it capable. The mere fact that the Examiner argues that it can does not make it so. There is nothing in the Nelson et al. reference that teaches or suggests that these bars of ink are capable of providing information for organizing digital images as taught and claimed by Applicant. The ordering of the particular number of items is obtained by sensing the particular number of bars present. There is no teaching or suggestion that these could provide instructions for organizing digital images. The Examiner argues that the structure

of Nelson is capable of performing the intended use, however, there is no teaching or suggestion in Nelson or any other references that this is possible. Thus, on this basis alone the Nelson reference could not teach or suggest the claimed invention. Further, claim 1 specifically states that the order form is to be completed by the customer. There is nothing to complete in the Nelson et al. reference but simply the tearing a part off a particular element of the card. Thus, there is nothing for the customer to complete. Nelson merely discloses using these for ordering particular items. There's no teaching or suggestion as to what these items can or should be. Clearly it does not teach or suggest the providing of hard copy prints which will be scanned to provide digital images that are to be provided in particular groups or categories as taught and claimed by Applicant. Thus, Applicant respectfully submits that the Nelson reference does not teach or suggest the invention as set forth in independent claim 1. Accordingly, independent claim 1 and its dependent claims are allowable over the cited prior art.

The Examiner has also maintained the rejection of claim 1 using the combination of Wentworth, Hicks and Johnson for the reasons set forth therein. In this regard, Applicant submits that the three cited references are each directed to totally and distinct areas that are unrelated to each other. First, the Wentworth reference is simply directed to a filing system for storing, organizing and handling documents. In particular it is directed to a container 11 such as a file cabinet in which hanging folders 12 are provided (see column 3 lines 22-25). Inside each of these folders documents may be placed. This reference teaches the use of color using colored folders when same color folders contain the same related matter (see column 3, lines 33-33). Clearly this is not directed to organizing digital images obtained from scanning hardcopy prints nor does it teach or suggest providing instructions or order forms for ordering goods or services. Quite the contrary, this is simply directed to a hardcopy filing system. The Johnson et al. reference is directed to a novel form and system for creating and interpreting such the form (see column 4, lines 9-11). The type of form that may be created is irrelevant in the Johnson et al. reference. The Johnson et al. reference is not directed to providing an order form for ordering image products or organizing digital images to which the present invention is directed. It is respectfully submitted that Johnson et al. is directed to a field totally apart and distinct from the Wentworth reference. The remaining reference to Hicks is

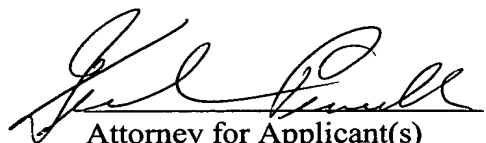
directed to an order form for ordering of image products. As illustrated by Figure 2, the various order packages are identified as different type image products that may be provided in different packages. There is no teaching or suggestion of providing a code capable of organizing digital images obtained from scanning hard copy prints. As can be seen, the three cited references are directed to three totally separate and distinct fields. In order to properly combine references there must be some teaching or suggestion of combining the references. See *In re Lee* 277 Fed 3rd 1338 (61 USPQ 2nd 1430) CAFC 2002. In particular see page 1443 when the court says:

“teachings of references can be combined only if there is some suggestion or incentive to do so.”

As the three references are directed to three totally different and distinct fields, there is no teaching in any of the references of making the suggested combination by the Examiner. Thus, for this reason alone the rejection must fail. In addition, even if one were to combine the references, none of them would teach or suggest the invention as taught and claimed by Applicant.

In summary Applicant respectfully submits that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Frank Pincelli', is written over a horizontal line.

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